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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,791	05/09/2001	Hiroshi Kutsumi	MTS-3257US	3296

7590 06/15/2004

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Valley Forge, PA 19482-0980

EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/851,791

Applicant(s)

KUTSUMI ET AL.

Examiner

Robert M. Pond

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 20-22 and 37 is/are objected to.
- 8) ☒ Claim(s) 1-19, 23-36, and 38-41 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Claim Objections*

Claims 20, 21, 22, and 37 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims cannot be treated on the merits.

### *Election/Restrictions*

A telephone call was made to Mr. Jack Jankovitz on 03 June 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 24 and 36, drawn to recommending items, classified in class 705, subclass 27.
- II. Claims 2 and 25, drawn to recommending items, classified in class 705, subclass 27.
- III. Claims 3 and 26, drawn to scoring items for recommendation, classified in class 705, subclass 10.
- IV. Claims 4 and 27, drawn to recommending based on thesaurus, classified in class 705, subclass 3.

V: Claims 5, 6, and 28, drawn to recommending based on frequency, classified in class 705, subclass 10.

VI: Claims 7-13 and 29, drawn to recommending based on extraction, classified in class 705, subclass 10.

VII: Claims 14 and 30, drawn to recommending based on profile, classified in class 705, subclass 27.

VIII: Claims 15, 31, and 38 drawn to recommending based on extraction, classified in class 705, subclass 10.

IX: Claims 16 and 32, drawn to recommending based on calculating, classified in class 705, subclass 10.

X: Claims 17 and 33, drawn to recommending based on advertisements, classified in class 705, subclass 14.

XI: Claims 18-19 and 34 drawn to recommending based on advertisements, classified in class 705, subclass 14.

XII: Claims 23, 39 drawn to recommending based on calculating, classified in class 705, subclass 10.

XIII: Claims 35, drawn to recommending based on calculating, classified in class 705, subclass 10.

XIV: Claims 40 and 41 drawn to recommending based on assigning weight, classified in class 705, subclass 10.

The inventions are distinct, each from the other because: Inventions I-XIV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombinations as claimed because recommending items has separate utility. The subcombination has separate utility such as recommending based on a thesaurus, scoring, calculating, extracting, or a profile.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Because these inventions are distinct for the reasons given above and the search required for any group is not required for any other group, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Vincent Millin** can be reached on 703-308-1065.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

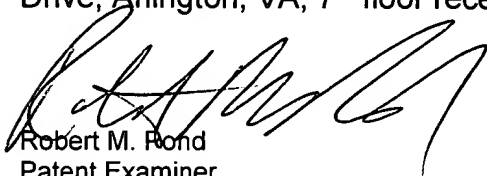
***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

**703-872-9306** (Official communications; including After Final  
communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

  
Robert M. Rond  
Patent Examiner  
June 14, 2004